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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/509,147	05/25/00	LADLOW	589377123

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EXAMINER
GURDON, B

ART UNIT	PAPER NUMBER
1743	

DATE MAILED: 09/14/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/509,147

Applicant(s)

LADLOW ET AL.

Examiner

Brian R. Gordon

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 May 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. PCT/EP98/05901, filed on September 17, 2001.

Information Disclosure Statement

3. The information disclosure statement filed October 23, 2000 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered ((AE) WO 98/20965 and (AA) 19543401). Reference AE does contain a translation of the abstract, but it is not enough to determine the relevance to the present application.

Drawings

4. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "guide means", "gas manifold", and "fixing means" must be shown and labeled or the feature(s) canceled from the claim(s). No new matter should be entered.

6. The drawings are objected to under 37 CFR 1.83(a) because they fail to show the adapter block and condenser as stated on page 4, line 20-32 (description of Figure 3) as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Correction is required.

Specification

7. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

8. The following guidelines illustrate the preferred layout and content for patent applications. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

The following order or arrangement is preferred in framing the specification and, except for the reference to "Microfiche Appendix" and the drawings, each of the lettered items should appear in upper case, without underlining or bold type, as section headings. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) Title of the Invention.
- (b) Cross-References to Related Applications.
- (c) Statement Regarding Federally Sponsored Research or Development.

Art Unit: 1743

- (d) Reference to a "Microfiche Appendix" (see 37 CFR 1.96).
- (e) Background of the Invention.
 - 1. Field of the Invention.
 - 2. Description of the Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) Brief Summary of the Invention.
- (g) Brief Description of the Several Views of the Drawing(s).
- (h) Detailed Description of the Invention.
- (i) Claim or Claims (commencing on a separate sheet).
- (j) Abstract of the Disclosure (commencing on a separate sheet).
- (k) Drawings.
- (l) Sequence Listing (see 37 CFR 1.821-1.825).

a. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71(a)-(c):

- (a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.
- (b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.
- (c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 because it is unclear exactly how the magnetic field is produced to allow for the stirring within the reaction vessels. It has been known in the art that in order to produce a stirring within a vessel (a) a magnetic field is produced below the vessel by means of rotating (or any other movement) of magnets to cause a magnetic stirring bar within the vessel to rotate or (b)

numerous magnets are placed below the vessels and the vessel themselves are moved relative to the stationary magnets. Applicant has not provided support for either of the above methods of producing a magnetic field for stirring (or any other method for providing the magnetic field).

9. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The fixing means of claim 1 has not been clearly defined or described in the specification.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the device comprising an adapter block, does not reasonably provide enablement for the device comprising a "fixing means". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. There is no description of the fixing means given within the specification. For the purpose of examination, the examiner has assumed the fixing means is referring to the adapter block which comprises the sockets in which the reaction vessels are held.

12. Claims 11-12 are rejected under 35 U.S.C. 112, first paragraph, because it is unclear which device applicant intends to claim. In claim 11, line 1 applicant claims "A magnetic or hotplate magnetic stirrer..." and later on line applicant claims "the magnetic field is generated by the laboratory hotplate", if the device comprises a magnetic stirrer rather than the hotplate then the magnetic field could not be produced by the hotplate.

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 11-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are indefinite because in claim 11, line 1 applicant claims "A magnetic or hotplate magnetic stirrer..." and later on line applicant claims "the magnetic field is generated by the laboratory hotplate", if the device comprises a magnetic stirrer rather than the hotplate then the magnetic field could not be produced by the hotplate.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

17. Claims 1-5, 8-9, and 11-12 rejected under 35 U.S.C. 103(a) as being unpatentable over Landsberger, US Patent 3,356,346.

Landsberger discloses a test tube stirring block for use in combination with a stirring machine. The support block 10 is made of vinyl material which allows it to hold a plurality of test tubes 12 (of any size) in apertures 20 (sockets) located about the perimeter of the circular block 10. While the fluid is in the test tubes it is stirred by a stirring magnet 26 that is attracted and repelled by conventional means such as a magnetic stirring machine. As seen in Figure 1 the test tubes are automatically guided into the appropriate position for stirring as they are placed within the apertures.

Although Landsberger does not specifically refer to elements of the invention in the exact terms as that of the applicant, it is obvious that the device of Landsberger does meet the limitations of the claims as stated above in the previous paragraph. Landsberger teaches that the block is formed from a vinyl material; it is well known in the art that vinyl is a chemical resistant material especially when combined to form other materials that have numerous applications.

Art Unit: 1743

18. Claims 1-5, 8-9, and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zakaria et al. US Patent 5,206,479.

Zakaria et al. discloses a microwave heating system that also comprises a mixer that is a combination of an external magnet and mixing element which is moved by changes in a magnetic field set up by the magnet by an oscillating turntable. Chamber 17 confines the microwave radiation therein, preferably within stainless steel or aluminum walls, etc. Such alloy and metal do not interfere with magnetic flux generated about the mixing magnets, which drive the mixers. The device also comprises a supporting deck 43 and a positioning deck 45 designed to support and position a plurality of walled containers 47 or 55. The container 55 has a magnetic stirrer 79 located within its interior and are moved accordingly by magnets 91, which are positioned under the bottom the containers. A stir plate may also be employed to initiate the stirring motion of the magnetic stirrers.

Although Zakaria does not specifically refer to elements of the invention in the exact terms as that of the applicant, it is obvious that the device of Zakaria does meet the limitations of the claims as stated above in the previous paragraph. As seen in Figure 1, Zakaria has a decks and apertures that are used to support and position the containers for heating and stirring.

Allowable Subject Matter

19. Claim 12 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Art Unit: 1743

20. The following is a statement of reasons for the indication of allowable subject matter: The prior art of Landsberger and Zakaria et al do not disclose a magnetic stirrer that comprises a condenser.

Conclusion


21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art, Matte et al., Wik, Stiegelmann et al., Carr, and Kundermann et al., disclose magnetic stirring devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian R. Gordon whose telephone number is (703) 305-0399. The examiner can normally be reached on M-F, with 2nd and 4th F off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 703-308-4037. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7719 for regular communications and (703) 305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

BRG
September 6, 2001


Jill Warden
Supervisory Patent Examiner
Technology Center 1700